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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,217	07/02/2001	Nobuyuki Tanaka	204080/00	8539
30743	7590	09/20/2004		
WHITHAM, CURTIS & CHRISTOFFERSON, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON, VA 20190				
			EXAMINER PATEL, SHEFALI D	
			ART UNIT 2621	PAPER NUMBER

DATE MAILED: 09/20/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/895,217

Applicant(s)

TANAKA, NOBUYUKI

Examiner

Shefali D Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: **reference 905 is not in the specification but it is shown in Figure 9**. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
2. Figures 8-10 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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**Please note: on page 7 of the specification figures 8-10 are disclosed as a conventional device, and later on page 8 lines 7-8, Figure 8 is referred as "prior-art."**

***Specification***

3. The disclosure is objected to because of the following informalities: On page 8 line 12, Figure 8 should be Figure 9.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 6, 11, 16, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung et al. (US 6,310,962) (hereinafter, "Chung") in view of Ryan, et al. (US 6,374,036) (hereinafter, "Ryan").

With regard to **claim 1** Chung discloses a device that embeds an electronic watermark into an original image (Figure 6), comprising: a circuit that performs discrete cosine transform (DCT) for the original image to output DCT coefficients (DCT unit 214, col. 7 line 61, see the prior art description at col. 2 line 67 to col. 3 line 1-3); a circuit that embeds the watermark into the DCT coefficients (watermark inserter 240, col. 8 lines 20-21, 27-38); a circuit that quantizes the DCT coefficients into which the watermark is embedded (quantizer 216, col. 8 lines 22-26, 38-45); and a circuit that variable-length encodes the quantized DCT coefficients (variable-length-coder 236, col. 8 lines 22-23, 45-47). Chung does not expressly disclose the watermark

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containing in a part thereof an instruction to an electronic watermark detection device. Ryan discloses the watermark containing in a part thereof an instruction to an electronic watermark detection device (Chung discloses the watermark containing instruction such as “copy-once,” “copy-never,” “copy no more,” etc. at col. 4 lines 33-36, 64-66, col. 5 lines 22-29). Ryan and Chung are combinable because they are from the same field of endeavor, i.e., watermark encoder/decoder system. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Chung with Ryan. The motivation for doing so is to offer improved economics and security over the existing art as suggested by Chung at col. 2 lines 30-33. Therefore, it would have been obvious to combine Chung with Ryan to obtain the invention as specified in claim 1.

With regard to **claim 2** Ryan discloses the electronic watermark as eight-bit data (col. 4 lines 26-28) and the instruction is four-bit data (col. 4 lines 39-42, col. 5 lines 23-29).

With regard to **claim 3** Ryan discloses instructions to display characters (col. 5 lines 59-62 where “copy-once,” “copy-never,” “copy no more,” etc. is being displayed).

With regards to **claims 4-5**, it would have been obvious matter of design choice to modify Ryan’s reference by having an instructions to access a website on the internet or start an application process since applicant has not discloses that having an instructions to access a website on the internet or start an application process solves any stated problem or is for any particular purpose and it appears that Ryan’s invention of having instructions for “copy-once,” “copy-never,” “copy no more,” etc. would perform equally well with having an instructions to access a website on the internet or start an application process (as disclosed in Ryan at col. 16 lines 22-25).

**Claim 6** recites identical features as claim 1 except claim 6 is a device that detects (instead embeds) an electronic watermark. Please note the watermark remover 270 in Figure 7 and respective portions in the specification in Ryan's reference. Thus, arguments similar to that presented above for claim 1 is equally applicable to claim 6.

**Claim 7** recites identical features as claim 2. Thus, arguments similar to that presented above for claim 2 is equally applicable to claim 7.

**Claim 8** recites identical features as claim 3. Thus, arguments similar to that presented above for claim 3 is equally applicable to claim 8.

**Claims 9-10** recites identical features as claims 4-5. Thus, arguments similar to that presented above for claims 4-5 is equally applicable to claims 9-10.

**Claim 11** recites identical features as claim 1 except claim 11 is a method claim. Thus, arguments similar to that presented above for claim 1 is equally applicable to claim 11.

**Claim 12** recites identical features as claim 2. Thus, arguments similar to that presented above for claim 2 is equally applicable to claim 12.

**Claim 13** recites identical features as claim 3. Thus, arguments similar to that presented above for claim 3 is equally applicable to claim 13.

**Claims 14-15** recites identical features as claims 4-5. Thus, arguments similar to that presented above for claims 4-5 is equally applicable to claims 14-15.

**Claim 16** recites identical features as claim 6 except claim 11 is a method claim. Thus, arguments similar to that presented above for claim 6 is equally applicable to claim 16.

**Claim 17** recites identical features as claim 12. Thus, arguments similar to that presented above for claim 12 is equally applicable to claim 17.

**Claim 18** recites identical features as claim 13. Thus, arguments similar to that presented above for claim 13 is equally applicable to claim 18.

**Claims 19-20** recites identical features as claims 14-15. Thus, arguments similar to that presented above for claims 14-15 is equally applicable to claims 19-20.

**Claim 21** recites identical features as claim 1 except claim 21 is a computer readable recording medium claim (Figures 6-7 of Chung). Thus, arguments similar to that presented above for claim 1 is equally applicable to claim 21.

**Claim 22** recites identical features as claim 6 except claim 22 is a computer readable recording medium claim (Figures 6-7 of Chung). Thus, arguments similar to that presented above for claim 6 is equally applicable to claim 22.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6,427,020; US 6,285,775; US 6,453,053; US 6,192,138; US 6,707,465; US 6,668,068; US 6,643,382

Wu, et al., "Image Refining Technique Using Digital Watermarking," Oct. 6, 1999, IEEE, pp. 1-5.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shefali D Patel whose telephone number is 703-306-4182. The examiner can normally be reached on M-F 8:00am - 5:00pm (First Friday Off).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo H Boudreau can be reached on 703-305-4706. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**DANIEL MIRIAM**  
**PRIMARY EXAMINER**

Shefali D Patel  
Examiner  
Art Unit 2621

September 14, 2004